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FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
NGUYEN, KIET TUAN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIALS AND APPEALS BOARD

Ex parte CRAIG M. WHITEHOUSE, THOMAS DRESCH, and BRUCE ANDRIEN

Appeal 2011-005081
Application 09/901,428
Technology Center 2800

Before JOSEPH L. DIXON, THU A. DANG, and JAMES R. HUGHES, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 99 and 115. These claims have been copied from U.S. Patent No. 6,285,027 to Chernushevich on September 3, 2002, in order to provoke an interference therewith. An oral hearing was held on November 20, 2012. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

According to Appellants, the invention relates to the mass analysis, and analyzing chemical species (Spec. 1, ll. 10-11).

B. ILLUSTRATIVE CLAIMS

Claim 99 is exemplary:

99. A method of effecting mass analysis on an ion stream, the method comprising:

(a) passing the ion stream through a first mass resolving spectrometer, to select parent ions having a first desired mass to charge ratio;

(b) subjecting the parent ions to collision induced dissociation to generate fragment ions;

(c) trapping the fragment ions and any remaining parent ions;

(d) periodically releasing pulses of the trapped ions into a Time-Of-Flight instrument to detect ions with a second mass to charge ratio; and

(e) providing a delay between the release of the pulses of trapped ions and initiation of pulses in the Time-Of-Flight instrument, and adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio.

C. REJECTION

The art relied upon by the Examiner in rejecting the claims on appeal is:

Chernushevich U.S. 6,285,027 B1 Sep. 4, 2001

Claims 99 and 115 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 99 and 115 stand rejected under 35 U.S.C. § 102(e) as anticipated by Chernushevich.

II. ISSUES

The dispositive issues before us are whether the Examiner has erred in finding that:

1. "*means for* providing a delay between the release of the pulses of trapped ions and initiation of pulses or push-pull pulses in the Time-Of-Flight instrument," and "*means for* adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ration" (Ans. 5, emphasis added) are not supported by the Specification.

2. Chernushevich qualifies as prior art.

III. ANALYSIS

35 U.S.C. § 112, first paragraph

The Examiner finds that "[t]he specification is completely silent in reciting and teaching the following limitations: a) 'means for proving a delay….,' and b) 'means for adjust the delay…' as recited in claims 99 and 115" (Ans. 5). However, Appellants contend that "the Examiner continues to misquote appellant's claims as reciting '*means for* providing a delay…' and '*means for* adjust the delay'" (Reply Br. 3). In particular, Appellants contend that "appellant's claims include no such recitations and the Examiner's contentions regarding such 'means' are misdirected" (Reply Br. 3-4). According to Appellants, "the Examiner has provided no legal authority supporting his contention that [reciting 'a method for operating a mass spectrometer' in the preamble] would somehow require that 'all features that are used to operate the mass spectrometer must show on the Drawing[s]'" (Reply Br. 4).

Upon review of the record, we agree with Appellants. In particular, we agree with Appellants that the Examiner is misquoting Appellants' claims "as reciting 'means for providing a delay…' and 'means for adjust the delay'" (Reply Br. 3). That is, both of claims 99 and 115 are method claims, and neither claim recites any "means for" as quoted by the Examiner.

It is incumbent upon the Examiner to demonstrate that the application disclosure as originally filed does not provide written descriptive support for the concept of what is later claimed. *In re Anderson*, 471 F.2d 1237, 1242, (CCPA 1973); *Ex parte Parks*, 30 USPQ2d 1234 (BPAI 1993); *Ex parte*

Grasselli, 231 USPQ 393 (BPAI 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). Here, by finding that "[t]he specification is completely silent in reciting and teaching the following limitations: a) 'means for proving a delay….,' and b) 'means for adjust the delay…'" (Ans. 5), neither of which is recited in claims 99 and 115, the Examiner has not made a clear showing what language in claims 99 and 115 introduces a new concept not provided in the application disclosure.

Accordingly, we find that the Examiner has failed to meet the initial burden of proof required for the rejection pursuant to 35 U.S.C. § 112 first paragraph, and we are constrained to reverse this Examiner's rejection of claims 99 and 115.

35 U.S.C. § 102(e)

Appellants claim priority to US Patent No. 5,689,111 (App. Br. 5). This claim for priority as amended in 2001, 2006, and 2008 appears to be facially correct.

In view of the claim of priority and further in view of our reversal of the Examiner's rejection of claims 99 and 115 as failing to comply with the written description requirement, claims 99 and 115 appear to receive the benefit of the filing date of US Patent No. 5,689,111. Thus, Chernusevich appears to be disqualified as a prior art reference under 35 U.S.C. § 102(e).

Accordingly, we also *sua sponte* reverse the Examiner's rejection of claims 99 and 115 over Chernusevich.

IV. CONCLUSION AND DECISION

The Examiner's rejection of claims 99 and 15 under 35 U.S.C. § 112, first paragraph is reversed, and the rejection of 35 U.S.C. § 102(e) is *sua sponte* reversed due to the disqualification of the prior art reference.

REVERSED

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